

### **REMARKS**

In the Official Action dated January 12, 2005, the Examiner that claims 30 and 31 read on the elected method of use, i.e., method of treating arthritis. Claims 1-27, 30 and 31 have been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,696,464. Claim 31 has been rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 31 is rejected under 35 U.S.C. §101 as allegedly claiming the recitation of a use without setting forth any steps involved in the process. Claims 1-27, 30 and 31 have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-5, 15 and 51-53 of U.S. Patent No. 6,696,464.

This response addresses each of the Examiner's objections and rejections. Accordingly, the present application is in condition for allowance. Favorable consideration of all pending claims is therefore respectfully requested.

Claims 30 and 31 has been amended and Claims 28, 29, 32 and 33 have previously been cancelled for being drawn to a non-elected subject matter. Applicants reserve the right to file continuing applications drawn to the deleted subject matter. No new matter has been added. Applicants respectfully request entry of this amendment.

The Examiner requested that claims 30 and 31 should be amended to read on the elected method of use, i.e., method of treating arthritis. For purposes of expediting prosecution, Applicants have amended claim 30 to make this claim readable on arthritis. Applicants reserve the right to prosecute method claims for treating the deleted subject matter in continuing

applications. In addition, Applicants have amended composition claim 31 by deleting all mention to any diseases in this claim for reasons stated herein below.

Claims 1-27, 30 and 31 have been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,696,464. Applicants respectfully traverse.

The '464 patent cannot preclude patentability of the claimed invention under 35 U.S.C. § 103(c). 35 U.S.C. § 103(c) states that

“Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person”.

In the instant case, the '464 patent and the present application were commonly owned by Pfizer Inc. at the time the present invention was made. In order to provide the requisite evidence required to establish common ownership of the '464 patent and the present application, Applicants hereby make the following statement in accordance with MPEP 706.02(1)(2).

#### **STATEMENT OF COMMON OWNERSHIP**

Applicants of U.S. Serial No. 10/649,236 state, in a clear and conspicuous manner, that:

U.S. Serial No. 10/649,236 and U.S. Patent No. 6,696,464 were, at the time the invention of U.S. Serial No. 10/649,236 was made, owned by Pfizer Inc.

Because the '464 patent can only qualify as prior art under subsection (e) of 35 U.S.C. §102, 35 U.S.C. §103(c) dictates that the '464 patent does not preclude patentability of the claimed invention.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. §103(a).

Claim 31 has been rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner alleges that Claim 31 provides for the use of the treatment of arthritis, but does not set forth any steps involved in this process. For purposes of expediting prosecution, Applicants have amended Claim 31 as suggested by the Examiner. There is no method or use language in Claim 31. Claim 31 merely describes a pharmaceutical composition containing a compound according to claim 1. Since Claim 31 is a proper pharmaceutical composition claim, Applicants respectfully request reconsideration and withdrawal of this rejection.

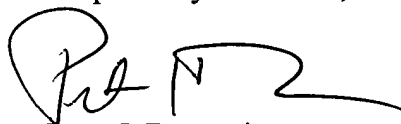
Claim 31 was also rejected under 35 U.S.C. §101 for allegedly claiming the recitation of a use without setting forth any steps involved in the process. For the same reasons stated above, Claim 31 merely describes a pharmaceutical composition containing a compound according to claim 1. Since Claim 31 is a pharmaceutical composition claim and not a process claim, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 1-27, 30 and 31 have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-5, 15 and 51-53 of U.S. Patent No. 6,696,464. In response, Applicants will submit a terminal disclaimer in compliance with 37 CFR §1.321(c) signed by a registered attorney of record upon the indication

of allowance subject matter. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Thus, in view of the foregoing amendments and remarks, the application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter I. Bernstein', with a large, stylized initial 'P' and a long horizontal flourish extending to the right.

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